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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,476

10/05/2006

Masao Sudoh

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EXAMINER

SZNAIDMAN, MARCOS L

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

01/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,476	<b>Applicant(s)</b> SUDOH ET AL.	
	<b>Examiner</b> MARCOS SZNAIDMAN	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2 pages / 08/08/2008 and 12/29/08</u> . | 6) <input type="checkbox"/> Other: _____  |



### **DETAILED ACTION**

This office action is in response to applicant's reply filed on October 15, 2008

#### ***Status of Claims***

Claims 1-15 are currently pending and are the subject of this office action.

Claims 14-15 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 18, 2007.

Claims 1-13 are presently under examination.

#### ***Priority***

The present application is a 371 of PCT/JP04/14896 filed on 10/01/2004, and claims priority to foreign application: JAPAN 2003-345125.

#### ***Rejections and/or Objections and Response to Arguments***

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated (Maintained Rejections and/or Objections) or newly applied (New Rejections and/or Objections, Necessitated by Amendment or New Rejections and/or Objections not Necessitated by Amendment). They constitute the complete set presently being applied to the instant application.

***Claim Rejections - 35 USC § 103 (Maintained Rejection)***

Claims 1-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Toda et. al. (US 6,608,221) in view of Black (US 6,043,223) or Sakanaka (US 2003/0104079).

The reasons for this rejection have been provided in the previous office action dated August 12, 2008, the text of which is incorporated by reference herein.

Applicant's arguments have been fully considered but are not persuasive.

Applicant argues that the references of Black and Sakanaka deal with infusions of compounds that are not related to the one in the instant application, so the skilled in the art would have not been motivated to combine these two references with the Toda reference that describes the compound (2R)-2-propylocatnoic acid.

Examiner's response: Making infusions of known compounds does not require any inventive steps. It is an extremely well known technique in the pharmaceutical/medicinal art. The two references: Black and Sanaka are two of the thousands that the Examiner could have provided to show applicant this point. Most of them include physiological saline distilled water, phosphate buffer, glucose solution, electrolytes, etc. Even though the structures disclosed by Black (Bradykinin, a peptide) and Sakanaka (Dihydroginsenoside, a steroid with sugar moieties covalently attached) are structurally different from the instant claimed structure (2-propylocatnoic acid, an

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aliphatic acid), the point made by the references of Black and Sakanaka is that infusions are universally known and have been used extensively with an enormous variety of compounds such as determining the exact components and the quantity of each element of an infusion would be obvious to the skilled in the art for a particular pharmaceutical agent.

### ***Withdrawn Rejections and/or Objections***

#### ***Claims rejected under Nonstatutory Double Patenting***

Applicant submitted a Terminal Disclaimer

Rejection under Nonstatutory Double Patenting is withdrawn.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/

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Examiner, Art Unit 1612

January 13, 2009

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612